REMARKS

[01]   Reconsideration of the present application is respectfully requested in view of the comments submitted herein.

[02]   Applicant thanks the Examiner for the entry of the proposed amendment, as well as the prompt issuance of the Advisory Action. Applicant would like to explain that the now-amended claims place the above-identified application in condition for allowance as below:

[03]   As previously mentioned, Drucker's disclosure is entirely on the search aspect of the retrieval, whereas the present invention is directed to the preparatory, or pre-printing, aspect, as well as the retrieval aspect. With the claimed limitations of first assigning a unique tag, and then printing the tag with the article when it is printed, a reader can now easily "clip" (electronically) the printed article in its electronic format, after the reader has read the printed article (and noticed the tag nearby). Drucker provides no teaching about these prior preparatory aspects; nor does it disclose whether the articles were even "printed" with their unique tags. That is, Drucker does not disclose whether the tags were ever uniquely assigned to the articles, and then printed along with the printed articles.

[04]   In contrast to Drucker, claims 1 and 10 recite the unique tags being assigned to the articles prior to print, and being printed with the articles when they are published in print. Drucker has no mention of how the articles are prepared prior to print. In Drucker, col. 4, lines 25-26, Fig. 6 C, Drucker teaches that at the SEARCH phase, the user may do various activities, but such activities are only to be conducted after the search result has been reported to the user. Even in Drucker, col. 8, lines 47-52, where it teaches that the full text of the articles may be assigned a URL tag, this is still at the SEARCH phase where the search result is to be notified to the reader. Despite its apparent utility, Drucker's Search Notification is entirely a different aspect from the Pre-Printing aspect of the claimed invention.

[05]   The Examiner seems to be persistently misapplying the above-cited Drucker passages, without regards to what the claimed invention is, or what the claimed limitations are. For example, the following limitations in claim 1 (*emphasis added*) are quite different from Drucker:

        ...

        "assigning said at least one article with at least one unique tag prior to print;"

        "publishing said at least one article in print with its corresponding tag;"

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...

[06]   In Drucker, there is no teaching of the unique tag having been assigned to the article prior to being printed with the printed article. Also, there is no teaching in Drucker of such articles having been printed with their corresponding tag. What Drucker discloses about its Search Notification, col. 8, lines 47-52, as relied on by the Examiner, thus has no bearing on, nor relevance to, how the tags are assigned before printing, and how the articles are subsequently printed with the tags. Drucker's teaching comes into play, presumably AFTER the articles are already collected and assembled in its database (516). With the articles in place, Drucker's system is directed to providing an improved access to literature and publication from its database. How the tags are initially assigned and whether the tags are printed with the printed article are simply no concern of Drucker. Nor does Drucker disclose any of such aspects.

[07]   As stated by the Federal Circuit in Motorola, Inc. v. Interdigital Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997):

> *For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art. See In re Spada, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990) ("[T]he [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." (citations omitted)). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there.*

[08]   Drucker clearly does not teach, among other things, (1) that unique tags are first assigned to the articles, prior to them being printed, and (2) that the unique tags are printed along with their corresponding articles. Such pre-print aspects are simply not a concern of Drucker.

[09]   The present invention allows a reader of a newspaper article, or even an advertisement, to use that tag, which has been uniquely assigned to and physically printed with the article in the newspaper, to quickly "clip" the desired article in electronic format. The reader no longer has to fumble around in the newspaper's website to look for the article to download. The present invention provides a quick and efficient way to effectively "clip and save" the printed article in its electronic format, which makes searching and forwarding quite easy. While Drucker may be beneficial in its "search" world, the quick "clip and save" of an article the reader has just read is not something Drucker intends to, nor can it, solve. According to Drucker, its search function is directed to those, particularly physicians, who have been unable to "peruse each of the journals

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and other literature sources to find those articles that are most relevant" to their practices (Drucker, col. 1, lines 30-33).

[10]   In contrast, the present invention is directed to those who have read the hardcopy of the articles and noticed the associated tags. For example, having just read an article in the print version of *The Washington Post*, the reader may wish to "clip" it for her own archive, or pass it onto a colleague, preferably via an email. With the tag already uniquely associated and printed with the printed article, the reader simply uses that tag to clip, via wired or wireless Internet, this article in electronic format. The "pre-print" aspects are not disclosed, nor taught, by Drucker.

[11]   Therefore, the Sec. 102 rejection based on Drucker of claims 1-8, 10-11 is not appropriate and should be withdrawn. Also, due to Drucker's inapplicability, the Sec. 103 rejection of claims 9, 12, and 15-17, and of claim 18, based on Drucker and Loeb, and Drucker, Loeb and Walker, respectively, should also be withdrawn accordingly.

[12]   A Request. As unusual as the following request may seem, Applicant would like to invite the Examiner to try to mentally "walk through" the present invention by trying to "clip" an article the Examiner has just read from *the Washington Post, USA Today* or *Wall Street Journal*. If the unique tag were printed with the article the Examiner has just read, the Examiner would be able to electronically "clip" it for his own archive, or for passing it on to a colleague via email. Without the tag, the Examiner would have to go to the newspaper's website to download it, after going through possibly layers of web browsing within that site. Or, the Examiner can simply physically cut it, the old-fashioned way, from the printed newspaper and save it in a physical file, hoping that it would be easy to remember which subject file the article piece went at a later time.